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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,911	09/26/2003	Michael J. Sullivan	P-3170-1-1-F2-2-C1-C1-D1	9194
24492	7590	08/19/2005	EXAMINER	
THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED SUBSIDIARY OF CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD LEGAL DEPT CARLSBAD, CA 92008-7328			BUTTNER, DAVID J	
		ART UNIT		PAPER NUMBER
		1712		
DATE MAILED: 08/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/672,911	SULLIVAN ET AL.
	Examiner	Art Unit
	David Buttner	1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 6/17/05.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Parent applications 7-559177 and 8-645185 each lack basis for blends of two or more of the olefin/acrylate/acrylic acid terpolymer ionomers and dimensions now claimed. Application 7-865212 lacks support for the high amounts of soft ionomer and dimensions now claimed. Therefore, claim 23 has an effective filing date of 8/6/92.

Claim 23 rejected under 35 U.S.C. 103(a) as obvious over the FR2625909 Patent in view of Sullivan '740.

The examiner relies on US4884814 as a translation of the French document.

The reference exemplifies (#10) golf balls of Shore C 77 (table 2). Its cover is a blend of large amounts of surlyn AD8269 and surlyn AD8265 with lesser amounts of "hard" ionomers surlyn9910 and surlyn8528. Surlyn 9910 and 8528 qualify as applicant's hard ionomers (see table 1 of the reference). The surlyn AD ionomers are soft ionomers of ethylene/butylacrylate/methacrylic acid having applicant's physical properties (see table 1 of reference; applicant's spec page 20 line 1-3). The surlyn AD ionomers are methacrylic acid based rather than acrylic acid based. However, the reference teaches any unsaturated C3-C8 acid can used in the soft ionomer (col 4 line 51). One of ordinary skill in the ionomer and golf ball arts recognize methacrylic acid and acrylic acid as the two most common acids in ionomer covered golf balls. Use of other acids is extremely rare. One of ordinary skill would immediately envisage using acrylic acid or methacrylic acid from the disclosure of "C3 to C8 monocarboxylic acid". Note that the Board of Appeals Decision 2000-0062 in parent 8-645185 upheld the principle that acrylic acid is anticipated and obvious from the reference's disclosure.

The reference does not report the dimensions of the core and cover.

Sullivan shows ionomer covered two piece balls can have core diameters of 1.545" and cover thicknesses of 0.06-0.09" (col 5 line 25-62). It would have been obvious to keep the FR2625909 ball within these standard dimensions.

Claims 1,13,15-18 and 23-27 rejected under 35 U.S.C. 103(a) as being unpatentable over FR2625909 in view of Sullivan '740 in further view of the Research Disclosure 27103.

The FR2625909/Sullivan '740 combination does not explicitly recite "acrylic acid" for use in making the soft ionomer. The research disclosure explicitly teaches that both methacrylic and acrylic acid can be used in forming soft ionomers. It would have been obvious to use either acid when making the soft ionomers of FR2625909. Note that the Board of Appeals Decision 2000-0062 in parent 8-645185 upheld the principle that acrylic acid is obvious from the combination of references.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 23 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6193616.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims golf ball cover of at least one hard ionomer and at least one soft ionomer. "at least one " renders obvious two or more. The patent does not claim dimensions of the ball, but it is clear from the examples that core sizes of 1.542-1.572 and cover thicknesses of 0.054-0.069 were intended to be encompassed by the claims (col 15 line 23-26).

Claim 23 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6676537. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims golf ball cover of at least one hard ionomer and at least one soft ionomer. "at least one " renders obvious two or more. The patent does not claim dimensions of the ball, but it is clear from the examples that core sizes of 1.542-1.572 and cover thicknesses of 0.054-0.069 were intended to be encompassed by the claims (col 15 line 1-3).

Applicant's arguments filed 6/17/05 have been fully considered but they are not persuasive.

The new prior art rejections supply the missing dimensions now claimed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1712

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

8/16/05

DAVID J. BUTTNER
PRIMARY EXAMINER

David Buttner